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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,483	01/30/2006	Takao Saito	10873.1854USWO	3585

52835 7590 07/13/2007

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EXAMINER	
REDDY, KARUNA P	

ART UNIT	PAPER NUMBER
1713	

MAIL DATE	DELIVERY MODE
07/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,483	SAITO ET AL.	
	Examiner	Art Unit	
	Karuna P. Reddy	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 5/2/2006, 12/18/2006.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 3 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakanishi et al (US 4, 721, 647).

Nakanishi et al disclose an absorbent article comprising a base material of fibers a part or all of which fibers are hydrophobic and a water absorbent polymer a part or all of which is in the form of substantially spherical particles and has been bonded to said fibers to wrap them (column 2, lines 29-34). The invention article can be obtained by a process which comprises the steps of applying an aqueous solution of a water soluble ethylenically unsaturated monomer to the base material so that part of the solution drops may wrap and bond to fibers, polymerizing monomer to produce water absorbent polymer (column 2, lines 54-60). In order to improve the absorption performance, a crosslinking agent may be added to the monomer (column 4, lines 14-16). The proportion of polymer bonded in the form of frog's webs and beads and the size of polymer granules can be varied or controlled by varying the proportion of hydrophilic and hydrophobic fibers in the fiber web of the base material (column 5, lines 19-24).

The absorption performance required of a product is different depending on the kind of product, e.g., a paper diaper or a sanitary napkin (column 5, lines 53-55).

Therefore, Nakanishi et al anticipate the instant invention.

3. Claim 1 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Takemori et al (US 5, 075, 373).

Takemori et al disclose a water retention material with water absorbency which comprises finely divided particles of water absorbent resin and a hydrophobic material such as a thermoplastic resin, elastomer, sealant, paint or adhesive (abstract). It is preferred to subject the water absorbent resin to a crosslinking reaction with a crosslinking agent (column 4, lines 4-6). In one aspect of the invention, water retention material comprises water absorbent resin and a hydrophobic sealant. The water-absorbent resin is incorporated into a hydrophobic sealant as an ingredient thereof (column 6, lines 59-64) and reads on the partial containment of the hydrophobic substance in the absorbent resin particle. Examples of sealants include silicone sealants and modified silicone sealants (column 7, lines 8-10).

4. Claim 1, 6 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Suskind et al (US 5, 849, 816).

Suskind et al disclose discrete absorbent particles having a non-colloidal, water-resistant solid core and a hydrogel forming polymer substantially encapsulating the solid core (column 3, lines 46-49). An ethylenically

unsaturated monomer capable of polymerizing into a hydrogel forming polymer is suspended in the water immiscible solvent along with an initiator. The monomer is then polymerized such that the non-colloidal, water-resistant solid particles are individually and substantially encapsulated with a polymer coating (column 3, lines 55-60). The polymers can be crosslinked either during the polymerization or after the encapsulation (column 6, lines 53-55). The absorbent particles of the invention in combination with fibers can be used in an absorbent article such as disposable diapers (column 4, lines 2-4). The process of making absorbent particles is conducted in the presence of surface active agents (column 4, lines 53-55) and reads on the diffusing penetrating agent of claim 6.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2 and 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakanishi et al (US 4, 721, 647) or Takemori et al (US 5, 075, 373) or Suskind et al (US 5, 849, 816).

The discussion with respect to Nakanishi, Takemori et al and Suskind et al in paragraph 2, 3 and 4 respectively is incorporated here in by reference.

The prior art is silent with respect to the properties of the absorbent resin particle comprising crosslinked polymer and a hydrophobic substance.

However, in light of the fact that prior art teaches / discloses essentially the same composition as that of the claimed, one of ordinary skill in the art would have a reasonable basis to believe that the absorbent resin composition of prior art exhibits essentially the same property(ies). Since PTO cannot conduct experiments, the burden of proof is shifted to the applicants to establish an unobviousness difference. See In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Even if properties of the absorbent resin of instant claims and prior art examples are not the same, it would still have been obvious to one of ordinary skill in the art to make absorbent resin having the claimed properties because it appears that the references generically embrace the claimed absorbent resin and the person of ordinary skill in the art would have expected all embodiments of the reference to work. Applicants have not demonstrated that the differences, if any,

between the claimed absorbent resin and the absorbent resin of prior art give rise to unexpected results.

Conclusion

The "X" references (US 5, 075, 373) from the international search report has been considered and used in the rejection. The other "X" references have been considered but were not applicable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karuna P. Reddy whose telephone number is (571) 272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karuna P Reddy
Examiner
Art Unit 1713

/KR/

DAVID W. WU
SUPERVISORY PATENT EXAMINER
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